



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,655	06/24/2003	Shigeki Nakahara	1247-0516P	1274
2292	7590	04/06/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			NGUYEN, MADELEINE ANH VINH	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,655

Applicant(s)

NAKAHARA, SHIGEKI

Examiner

Madeleine AV Nguyen

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/19/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This communication is responsive to amendment filed on January 13, 2006.

Applicant cancels claims 1-14, adds new claims 15-16.

As requested, a telephone call with a left message was made to Ms. Carolyn T. Baumgardner on March 22, 2006. No response has been heard.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Concerning claim 15, “a plurality of copies of recording sheets”, “an image data signal ... is printed” and “by repeatedly printing the image data signal” are indefinite for the following reasons:

- how a plurality of copies of the recording sheets is defined: whether one copy refers to one recording sheet or to a plurality of recording sheets; whether the copies are the same or different from each other;
- whether the image data signal is printed on each of the recording sheets or each of the copies;

Art Unit: 2625

- clarification on how “preparing the plurality of copies of recording sheets” by “repeatedly printing the image data signal”: whether the image data signal is repeatedly printed many times on one side or both sides of one recording sheet, of all the recording sheets in each copy, or of all the recording sheets in all the copies, or one image data is printed one time on each of the recording sheets in each copies, or one image data is printed one time on any recording sheet of each copy.
- the timing order of the image data signal printed on a plurality of copies of recording sheets and the step of preparing a plurality of copies of recording sheets by “repeatedly printing the image data signal “

Concerning claim 16, a process of “bundling the copies one by one” is performed after the output operation is indefinite since there is no description on how the copies are distinguished and bundled one by one. Does it done manually, automatically, by request or command?

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi (US Patent No. 5,936,744) in view of Kurokawa (US Patent No. 4,811,111).

Concerning claim 15, Choi discloses a communication apparatus (Fig.2) receiving an identification signal (telephone number) from an originating communication apparatus (sending facsimile) and performing an output operation (printing operation) when the received identification signal from the original communication apparatus coincides with a pre-stored identification signal (registered telephone numbers), (Figs.3-4; col. 3, line 40 – col. 4, line 46; col. 5, line 12 – col. 6, line 61), wherein the output operation includes an operation for preparing a plurality of copies of recording sheets on which an image data signal received subsequent to the receipt of the identification signal is printed (col. 5, lines 8-10).

Choi fails to teach that the operation is performed by repeatedly printing the image data signal. However, it was commonly known in the art that some information, such as sender name or address, receiver's name or address, could be printed on each recording sheet. Kurokawa discloses a facsimile machine that prints sender's and receiver's name together with facsimile image data on each page of the recording sheets (Fig.4; Abstract; col. 4, line 41 – col. 5, line 39). It would have been obvious to one skilled in the art at the time the invention was made to combine the above Kurokawa teaching to repeatedly print any information relating to the sender and receiver (name, address, phone numbers, etc.) on the recording sheets since Kurokawa also teaches that the sending facsimile apparatus sends these information to the receiving facsimile in order to print them on the top or each page of facsimile recording sheets (Fig.4; col. 5, lines 4-39) while Choi teaches that the facsimile image data can be received by the receiver only when the sender's telephone numbers are registered in the receiver's register (col. 7, lines 17-24).

Concerning claim 16, Choi in view of Kurokawa fails to teach the process of bundling the copies one by one. However, at the time of the invention, it would have been obvious to a

Art Unit: 2625

person of ordinary skill in the art to add a process of bundling the copies one by one as a matter of design choice. Applicant has not disclosed that the bundling process provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the bundling process because a conventional printing or copying machine can do that process and it is up to the user to request the process of bundling the copies.

Therefore, it would have been obvious to combine to one of ordinary

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

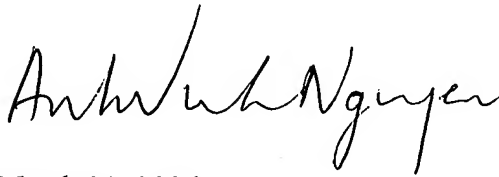
a. Nakatsuji (US Patent No. 5,296,933) discloses a facsimile apparatus from which paper sheets bearing an index mark.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Tuesday-Thursday 12:30-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Madeleine AV Nguyen
Primary Examiner
Art Unit 2625

March 31, 2006